

REMARKS

Claims 1 to 33 are now pending in the application, with claims 1 and 11 being the independent claims. Reconsideration and further examination are respectfully requested.

In the Office Action, claims 1 to 20 were rejected under 35 U.S.C. § 103(a) over U.S. Patent 6,394,622 (Macek) in view of U.S. Patent 5,903,103 (Garner). Withdrawal of this rejection is respectfully requested for the following reasons.

The present invention (as recited in independent claims 1 and 11) concerns a flashlight in which an integrated circuit or a multi-state device, in combination with a switch operable by a user, controls which of a plurality of different light sources is/are illuminated. In this way, it is often possible to utilize a simple switch in order to obtain a variety of different light beam characteristics.

For example, in the preferred embodiment described in the Specification, the flashlight utilizes a pushbutton switch that controls an input signal to an integrated circuit that is configured as a counter. Each combination of a depression and release of the pushbutton switch causes the counter to increment by one, and the output associated with each count can be hard-wired to illuminate any desired combination of light sources in the flashlight. As a result, in order to obtain a desired beam characteristic, the user would only need to depress and release the pushbutton switch a certain number of times until the desired beam is found.

As should be apparent, this ability to control a flashlight's beam through the use of an integrated circuit or multi-state device is quite different than conventional flashlights, which use mechanical switches alone and are therefore quite limited in their

Serial No. 10/029,482

ability to control a flashlight beam. The Macek patent illustrates one example of such a conventional flashlight. As discussed in column 4, lines 11 to 39, Macek uses two light sources (a light-emitting member 19 and a strobe light 22). These light sources are connected to an ordinary mechanical switch 21, which in turn is connected to internal batteries. See, e.g., column 4, lines 34 to 39. It appears from Figures 1, 5 and 10 that switch 21 is implemented in Macek as an ordinary slide switch having three positions: a center "off" position, a left position in which the left light source is illuminated, and a right position in which the right light source is illuminated.

The Office Action appears to recognize that Macek is merely directed to an ordinary conventional flashlight. However, in the Office Action it is asserted that one of ordinary skill in the art would have been motivated to combine the teachings of Garner with Macek's disclosure, and that such a combination would have rendered the present invention obvious.

In this regard, Garner concerns footwear that has embedded lights that flash under certain circumstances. More specifically, Garner's footwear includes a module 14 that causes the lights to illuminate when the wearer is walking or running. See, e.g., column 5, lines 38 to 48. The stated purposes of Garner's device are to provide an "attractive eye-catching display" and to make "the user more visible, e.g., to motorists, so that the safety of the user is increased." See, e.g., column 1, lines 47 to 50; column 3, lines 21 to 23; and column 3, lines 39 to 45. In short, the flashing of Garner's lights is an important feature for increasing the wearer's visibility, as well as for prolonging battery life. See, e.g., column 1, lines 44 to 50; and column 3, lines 21 to 27.

Given the vastly different purposes of the devices in Macek (a flashlight) and in Garner (flashing lights for shoes), it is not believed that there would have been any motivation whatsoever to combine these two references. That is, the primary purpose of a flashlight is to enhance a user's ability to see in dark places, while the primary purposes of Garner's flashing-light shoes are to make the wearer more visible and to provide some ornamentation. In fact, it appears that the only common features of these two devices are the use of lights and the inclusion of some form of the word "flash" in the descriptions of the devices. The mere fact that these similarities can be recognized in hindsight is not sufficient to show that one of ordinary skill in the art would have been motivated to combine the subject references.

In this regard, M.P.E.P. 2143.01 specifically states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." [Citation omitted, emphasis in original]. Here, Macek clearly does not suggest the desirability of incorporating a flashing light circuit, such as described in Garner. Similarly, Garner itself does not suggest the use of such a flashing light circuit in any application other than footwear. In fact, the Office Action does not cite to anything in either such reference that indicates such motivation to combine. Rather, the Office Action merely asserts that:

It would have been obvious to one having ordinary skill in the art, at the time that the invention was made, to provide the integrated circuit and switch of Garner for the device of Macek for purpose of controlling the illumination of the light source based on input signal of the switch.

Serial No. 10/029,482

The foregoing statement is not believed to be supported in any manner whatsoever by the applied art. Instead, it appears that the only motivation to combine these two references in the manner asserted would have been found in Applicant's own disclosure, which of course, is impermissible hindsight. To this point, the Federal Circuit has held as follows:

This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been lead to this combination of references simply to "[use] that which the inventor taught against its teacher." [Citation omitted].

In re Lee, 277 F.3d 1338, 1343-44 (Fed. Cir. 2000).

For the foregoing reasons, neither of independent claims 1 or 11 would have been obvious in view of the applied art. The other claims in the application depend from these independent claims and are therefore believed to be allowable for at least the same reasons. In addition, each such dependent claim recites an additional feature of the invention that further distinguishes the invention from the applied art. Accordingly, the individual consideration/reconsideration of each on its own merits is respectfully requested.

For instance, dependent claim 19 has been amended above to recite that the switch is a three-position rocker switch, depressing the switch in a first direction advances to a next state of the multi-state device, and depressing it in the second direction returns to a previous state of the multi-state device. This combination of features is not seen to be disclosed or suggested by the applied art.

Dependent claims 22 and 26 recite the features that each time the switch is activated, the integrated circuit or multi-state electronic device, respectively, causes at least one change in the light source(s), if any, that are illuminated, and the new set of illuminated lights source(s), if any, remain illuminated until the next activation of the switch. This combination of features also is not seen to be disclosed or suggested by the applied art. In fact, the primary purpose of the integrated circuit in Garner appears to be to flash the lights embedded within Garner's shoe.

Dependent claims 24 and 27 recite the feature that the integrated circuit or the multi-state electronic device, respectively, only changes state when a signal is input from the switch. However, in Garner, the integrated circuit changes state automatically after a specified count threshold has been reached. See, e.g., column 8, lines 57-61.

Dependent claim 28 recites that the multi-state electronic device transitions through a fixed number of states, with each transition caused by an identical activation of the switch, and with the multi-state electronic device returning to an initial state after transitioning through a fixed number of states. Garner's integrated circuit does not appear to transition through a fixed number of states with each transition caused by an identical activation of his switch, nor does his device then return to an initial state after doing so.

Claims 29 and 30 recite additional limitations to those recited in claim 28. These additional limitations also are not believed to be disclosed or suggested by the applied art.

In order to sufficiently distinguish Applicant's invention from the applied art, the foregoing remarks emphasize several of the differences between the applied art and

Serial No. 10/029,482

Applicant's invention. However, no attempt has been made to categorize each unobvious difference. Applicant's invention comprises all of the elements and all of the interrelationships between those elements recited in the claims. It is believed that for each claim, the combination of such elements and interrelationships is not disclosed, taught or suggested by the applied art. It is therefore believed that all claims in the application are fully in condition for allowance, and an indication to that effect is respectfully requested.

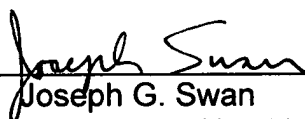
If there are any fees due in connection with the filing of this paper that have not been accounted for in this paper or the accompanying papers, please charge the fees to our Deposit Account No. 13-3735. If an extension of time under 37 C.F.R. 1.136 is required for the filing of this paper and is not accounted for in this paper or the accompanying papers, such an extension is requested and the fee (or any underpayment thereof) should also be charged to our Deposit Account. A duplicate copy of this page is enclosed for that purpose.

Respectfully submitted,

MITCHELL, Silberberg & KNUPP LLP

Dated: November 6, 2003

By


Joseph G. Swan
Registration No. 41,338

MITCHELL, SILBERBERG & KNUPP LLP
11377 West Olympic Boulevard
Los Angeles, California 90064
Telephone: (310) 312-2000
Facsimile: (310) 312-3100